

### **SECTION III—REMARKS**

This amendment is submitted in response to the Office Action mailed September 21, 2005. Claims 1, 12 and 34 are amended, and claims 1-22 and 34-44 remain pending in the application. Applicants respectfully request reconsideration of the application and allowance of all pending claims in view of the above amendments and the following remarks.

#### **Specification Objections**

The Examiner objected to the specification under 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o) for failing to provide proper antecedent basis for the claimed subject matter. According to the Examiner, the specification fails to provide proper antecedent basis for the language “the electrolyte has a pH equal to or greater than 10” originally presented in claims 6, 17 and 39.

Applicants respectfully direct the Examiner’s attention to the specification at page 7, lines 17-18, which discloses that “the electrolyte 204 includes a base and has a pH equal to or greater than 10.” Applicants respectfully submit that this provides proper antecedent basis for the language of claims 6, 17 and 39 referred to by the Examiner, and respectfully request withdrawal of the objection.

#### **Rejections Under 35 U.S.C. § 112**

The Examiner rejected claims 1-22 and 34-44 under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement because they contain subject matter not disclosed in the specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the invention at the

time the application was filed. Specifically, the Examiner alleges that the limitation “a base electrolyte” is new matter in that the Applicants’ specification only supports an electrolyte which includes “a base and has a pH equal to or greater than 11.”

Applicants respectfully traverse the Examiner’s rejections. Applicants have amended the claims to remove the limitation of “a base electrolyte.” Applicants submit that the Examiner’s rejection is moot in view of the amendments to the claims.

#### Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 1-22 and 34-44 under 35 U.S.C § 103(a) as obvious in view of, and therefore unpatentable over, U.S. Patent No. 6,780,772 to Uzoh *et al.* (“Uzoh”) in view of U.S. Patent No. 6,739,953 to Berman *et al.* (“Berman”).

Applicants respectfully traverse the Examiner’s rejections. To establish a *prima facie* case of obviousness, three criteria must be met: (1) the prior art references must teach or suggest all the claim limitations; (2) some suggestion or motivation to combine the references must be found in the prior art; and (3) there must be a reasonable expectation of success. MPEP § 2143. As explained below, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness.

Claim 1, as amended, recites a process combination including providing a wafer including a barrier layer, exposing the barrier layer, “placing the wafer in a base electrolyte” such that at least the barrier layer is immersed in the electrolyte, and applying an electrical potential between the wafer and an electrode immersed in the electrolyte until at least part of the barrier layer is removed. The Examiner concedes that Uzoh does not disclose the process details recited in the claims, but asserts that Berman discloses the

electropolishing details not disclosed in Uzoh, and that it would have been obvious at the time the present invention was made to combine Uzoh and Berman to arrive at the present invention.

Applicants respectfully disagree. Berman does not disclose the details of the claimed electropolishing process. Berman teaches that the wafer 102 should be put in a polishing head 106, but does not disclose, teach or suggest that the polishing head insures that electrolytic solution layer 215 affects only the surface of the wafer. Berman therefore does not disclose, teach or suggest that the wafer should be placed “in a holder such that, when the holder and the wafer are immersed in an electrolyte, the electrolyte will only affect a surface of the wafer.” Further, Berman teaches that the electrolytic solution 215 is disposed between the wafer 102 and the polishing pad 206, but does not disclose teach or suggest that both the holder and the wafer are immersed in the electrolytic solution 215. Berman therefore does not disclose, teach or suggest that the holder and the wafer should be immersed in the electrolyte “such that at least the barrier layer is wholly immersed in the electrolyte.” Uzoh and Berman, taken together, therefore cannot disclose, teach or suggest a combination including the recited limitations. For the above reasons, Applicants submit that Uzoh and Berman cannot obviate the claim. Applicants therefore respectfully request withdrawal of the rejection and allowance of the claim.

Regarding claims 2-11, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 1 is in condition for allowance. Applicants submit that claims 2-11 are therefore also allowable by virtue of their dependence on an allowable independent claim, as well as by virtue of the features

recited therein. Applicants therefore respectfully request withdrawal of the rejections and allowance of these claims.

Claim 12, as amended, recites a process combination including providing a wafer comprising a barrier layer, placing the wafer in a holder “such that, when the holder and the wafer are immersed in an electrolyte, the electrolyte will only affect a surface of the wafer,” and “immersing the holder and the wafer in the electrolyte such that at least the barrier layer is wholly immersed in the electrolyte.” By analogy to the discussion above for claim 1, Uzoh and Berman, when combined, do not disclose, teach or suggest a combination including the recited limitations. Applicants submit that Uzoh and Berman therefore cannot obviate claim 12 and respectfully request withdrawal of the rejection and allowance of the claim.

Regarding claims 13-22, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 12 is in condition for allowance. Applicants submit that claims 13-22 are therefore also allowable by virtue of their dependence on an allowable independent claim, as well as by virtue of the features recited therein. Applicants therefore respectfully request withdrawal of the rejections and allowance of these claims.

Claim 34, as amended, recites a process combination including providing a wafer comprising a barrier layer, exposing the barrier layer, placing the wafer in a holder “such that, when the holder and the wafer are immersed in an electrolyte, the electrolyte will only affect a surface of the wafer,” and “immersing the holder and the wafer in the electrolyte

such that at least the barrier layer is wholly immersed in the electrolyte.” By analogy to the discussion above for claim 1, Uzoh and Berman, when combined, do not disclose, teach or suggest a combination including the recited limitations. Applicants submit that Uzoh and Berman therefore cannot obviate claim 34, and respectfully request withdrawal of the rejection and allowance of the claim.

Regarding claims 35-44, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 34 is in condition for allowance. Applicants submit that claims 35-44 are therefore also allowable by virtue of their dependence on an allowable independent claim, as well as by virtue of the features recited therein. Applicants therefore respectfully request withdrawal of the rejections and allowance of these claims.

### Conclusion

Given the above amendments and accompanying remarks, all claims pending in the application are in condition for allowance. If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to allowance of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 292-8600.

Charge Deposit Account

Please charge our Deposit Account No. 02-2666 for any additional fee(s) that may be due in this matter, and please credit the same deposit account for any overpayment.

Respectfully submitted,

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